

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

5 In Re: Application of:  
**Allen Berger, Jr.**

Serial No.: **10/669,900**

Filed: **September 25, 2003**

For: "**SURFACE MOUNT WINDOW FOR DOORS**"

Atty. Dkt. No. **230199.3**



Date: **November 23, 2005**

Art Unit: **3635**

Examiner: **Robert J. Canfield**

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**BRIEF FOR APPELLANT**

15 Board of Patent Appeals and Interferences  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

20 Honorable Board Members:

This is an appeal from the Examiner of Art Unit 3635 finally rejecting claims 1 and 4 on appeal, and for which an amendment after final rejection 25 was presented to the Examiner for the purposes of this appeal. The claims on appeal are included in:

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**CLAIMS FILED WITH THE CONTINUATION  
APPLICATION (PRELIMINARY AMENDMENT)  
SURFACE MOUNT WINDOW FOR DOORS (230199.3)**

5           1. A window assembly for garage doors, comprising:

10          A) a transparent panel having an external surface and an internal surface, said external surface including a peripheral flange member making said external surface larger than said internal surface with respective external and internal\_peripheral edges, and said peripheral flange member further including a peripheral underside surface that comes in abutting contact against the peripheral external surface adjacent to an opening in a garage panel with cooperative dimensions to permit said internal surface to go through; and

15          B) means for mounting said transparent panel on said garage panel.

20          4. The window assembly set forth in claim 1 wherein said means for mounting said transparent panel on said garage panel includes:

25          C) an external frame assembly mounted on said garage panel around said external peripheral edge.

## **I. Status of Claims**

This application is a continuation of application serial No. 10/244,482 filed on September 17, 2002. Initially, Applicant filed a preliminary 5 amendment leaving two claims in this patent application. Claim 1 is derived from the parent application and new claim 4. The amendment filed on April 21, 2005, added the words "coplanarly extending" for clarification purposes. The amendment after final rejection (permitted by the examiner) replaced the word "go" with pass and added the words said 10 opening also for clarification purposes.

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## **II. Status of Amendments**

15 The Examiner entered the amendments mentioned above. The two pending claims read as included in the appendix.

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## **III. Summary of the Invention**

20 The present invention relates to a novel surface mount window for doors, such as overhead garage doors. The invention allows a user to readily mount a window to a panel door that can withstand substantial 25 wind loads.

## **IV. Issues**

Whether the claims are anticipated by U.S. patent No. 5,950,398 under section 102 (b) of Title 35?

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## **V. Grouping of Claims**

There is only one group of claims.

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## **VI. Argument**

15 References relied by the Examiner:

<u>Patentee</u>	<u>Patent No.</u>	<u>Publication date</u>
Hubbard	5,950,398	September 14, 1999

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The Examiner has rejected claims 1 and 4 under 35 U.S.C. §102 (b) as being anticipated by Hubbard. Applicant respectfully disagrees.

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### **1. The Claimed reference fails to anticipate the claimed invention.**

The Examiner has rejected claims 1 and 4 under 35 U.S.C. 102(b), as being anticipated by U.S. patent No. 5,950,398 to Hubbard. Applicant respectfully disagrees. Hubbard shows inner pane or interior glazing 18 that the Examiner has equated to Applicant's internal surface. Inner pane

18, however, does not pass through the opening of sash 10. Rather, pane 18 is kept “within” the sash, on rabbet 12 abutting against “inner” face 14.

Also, the claimed invention includes peripheral flange members that 5 come in abutting contact against the peripheral external surface adjacent to opening. Hubbard’s external surface 17 is also received within the opening, which is contrary to what is claimed herein. In sum, Hubbard teaches away from this invention.

The Examiner states: “If one considers the opening to be defined as 10 the space between reveal 16 and face 14...” p.2 of Advisory Action Before the Filing of an Appeal Brief. This assumption fails to take into consideration the explicit disclosure of the outer surface 13 of Hubbard’s double glazed pass-by window unit 11. The real opening of the sash is defined by its outer surface 13. The rabbet 12 is interiorly defined and it is 15 inside the opening. Therefore, the Examiner’s assumption is improper.

In claim 1 the peripheral flange comes in contact with the external surface. For Hubbard to anticipate Applicant’s claimed invention, the outside panel 17 needs to have a peripheral flange that comes in abutting contact with outer surface 13 and this is not disclosed in Hubbard.

20 Hubbard uses two panes 17 and 18. Applicant only utilizes one. Even if we were to combine pane 18 with pane 17, the combination does

not pass through the opening of a garage door panel opening. Panel 18 is shown in figures No. 3 to be inside the sash.

The Examiner's assumption is not inherent in the type of product described in Hubbard. Rabbets are used for recessing the panels in a sash.

5 This is not intended in the present invention. In this regard, the CCPA has stated that "[I]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Oerlich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981). Therefore, the Examiner's analogy is not  
10 saved by the limited application of inherency principle to overcome the burden of establishing anticipation.

There is no evidence in the record that one with ordinary skill will equate the internal opening defined by a rabbet or reveal 14 with the true opening of a sash. Nor that causing a panel to come in abutting  
15 relationship with reveal 14 puts the claimed invention in the hand of one skilled in the art. *In re Donohue*, 766 F.2d 531, 533, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

**VII. Appendix**  
**CLAIMS FILED WITH THE CONTINUATION**  
**APPLICATION (PRELIMINARY AMENDMENT)**  
**SURFACE MOUNT WINDOW FOR DOORS (230199.3)**

5        1. A window assembly for garage doors, comprising:

          A) a transparent panel having an external surface and an internal  
             surface, said external surface including a peripheral flange  
             member making said external surface larger than said internal  
             surface with respective external and internal peripheral edges,  
10        and said peripheral flange member further including a  
             peripheral underside surface that comes in abutting contact  
             against the peripheral external surface adjacent to an opening  
             in a garage panel with cooperative dimensions to permit said  
             internal surface to go through; and

15        B) means for mounting said transparent panel on said garage  
             panel.

20        4. The window assembly set forth in claim 1 wherein said means for  
             mounting said transparent panel on said garage panel includes:  
             an external frame assembly mounted on said garage panel around said  
             external peripheral edge.

C) an external frame assembly mounted on said garage panel around said external peripheral edge.

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## CONCLUSION

When this invention and the application's claims are fully analyzed and interpreted as explained above, it will be apparent that there is a good and clear difference between this invention and the cited prior art. When 10 all factors are taken into consideration and given their due weight, it is believed that the Board of Appeals will be able to reverse the Examiner and such is now requested.

Kindly charge or credit our Deposit Account No: **19-0129** for the 15 pertinent fees to cover the appeal brief fee. This Brief is filed in triplicate.

Respectfully submitted,

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re: Application of:  
**Dab Door Company, Inc.**

Date: December 6, 2005

Filing Date: September 25, 2003

Serial No. 10/669,900

Attorney Dkt. No. 230199.3

Title: "SURFACE MOUNT WINDOW FOR DOORS"

### EXPRESS MAIL CERTIFICATE

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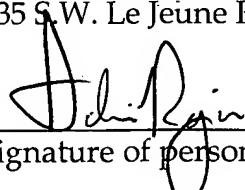
Date of Deposit: December 6, 2005

I hereby certify that this paper(s) or fee is hereby being deposited with the United States Postal Service's "Express Mail Post Office To Addressee" service pursuant to 37 C.F.R. §1.10 on the date indicated above and is addressed to the **Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450**. I have been warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001), and may jeopardize the validity of this application, document, registration or patent resulting therefrom.

#### Papers included:

- Transmittal Letter for your accounting purposes with copy
- Brief for Appellant
- postcard

Adrian Rojas, Patent Dept.  
235 S.W. Le Jeune Road, Miami, FL 33134

  
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Signature of person mailing paper(s) or fee

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Patents, Trademarks & Copyrights

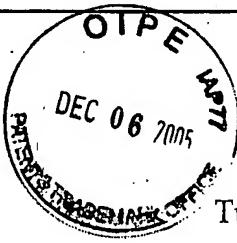
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Tuesday, December 6, 2005

Board of Patent Appeals and Interferences  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Re: "SURFACE MOUNT WINDOW FOR DOORS"

Serial No. 10/669,900

Examiner: Robert J. Canfield

Filing Date: September 25, 2003

Art Unit: 3635

Applicant: Allen Berger, Jr.

Atty. Dkt. No. 230199.3

Hon. Commissioner:

Enclosed please find the Brief for Appellant for the above-referenced patent application. Kindly charge our Deposit Account No: 19-0129 for the pertinent fees to file this Brief. A duplicate copy of this charge authorization is enclosed for your accounting purposes.

Please acknowledge receipt of the above by stamping the enclosed self-addressed, postage-paid card and returning it to our office.

Sincerely,

Adrian Rojas, for  
Jesus Sanchelima, Esq.

A handwritten signature in cursive ink, appearing to read "Adrian Rojas". Below the signature, the text "for Jesus Sanchelima, Esq." is printed in a smaller, sans-serif font.

JS/ar  
Encl.: Brief & postcard